

REMARKS/ARGUMENTS

These remarks are made in response to the final Office Action of October 4, 2004 (Office Action). As this response has been timely filed within the 3-month shortened statutory period, no fee is believed due.

Applicants, as an initial matter, wish to thank the Examiner for correctly noting at Page 2 of the Office Action that the application is eligible for continued examination under 37 C.F.R. § 1.114 and for having entered Applicants' amendment of August 6, 2004.

I. Claims 1-11 Are Directed To Statutory Subject Matter

In paragraphs 3-4 of the Office Action, claims 1-11 have been rejected under 35 U.S.C. § 101 "because the claims are directed to non-statutory subject matter, specifically, directed towards a data structure." Applicants respectfully point out that the claims are directed to a method for producing a concrete, tangible and useful result, namely, the creation or generation of a common contacts list. Applicants have amended independent Claim 1 to emphasize that the method is a computer-related process limited to a practical application in the technological arts. *See, e.g., AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). Accordingly, withdrawal of the 35 U.S.C. § 101 rejection regarding claims 1-11 is respectfully requested.

II. Applicants' Invention Predates Bloebaum

In paragraphs 5-6 of the Office Action, claims 1-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0023230 to Bolnick, *et al.* (Bolnick) in view of U.S. Publication No. 2002/0016857 to Harari (Harari) and in further view of U.S. Publication No. 2002/0098849 to Bloebaum, *et al.* (Bloebaum).

The Examiner correctly points out that none of the references singly teaches or suggests Applicants' invention. For example, as the Examiner notes, neither Bolnick nor Harari teach or suggest an exposed, remotely accessible contact list as defined by Applicants' invention. Nor do either teach or suggest, for example, generating and storing a common contacts list that defines

yet another distinct set and that contains identified common contacts, as with Applicants' invention.

Applicants respectfully disagree with the assertion that these deficiencies are cured by Bloebaum. The issue, however, is rendered moot in that Applicants' invention predates the effective date of Bloebaum. Applicants earlier submitted Affidavits under 37 C.F.R. § 1.131 along with a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2000-0100 (Disclosure) entitled "Connecting Persons Through Common Contacts." The earlier submission was in response to the April 24, 2003, Office Action in the case. The Examiner in a subsequent August 22, 2003, Office Action questioned whether the submission was sufficient to establish diligence from the date of conception to the filing of the application and noted an apparent difference between the Disclosure's creation and submission dates. Subsequently, however, the Examiner in an October 10, 2003, Office Action stated that "[t]he priority date of November 10, 2000 [is, sic] hereby considered." The references against which the submission was offered were withdrawn and new references cited by the Examiner in the October 10, 2003 Office Action.

In abundance of caution and to dispel any confusion regarding conception and due diligence on their part, Applicants hereby resubmit their Disclosure and earlier Affidavits along with new Affidavits. Based on these documents, it is established that the invention was conceived at least as early as November 10, 2000, the date the Disclosure was created by the inventors, and no later than November 27, 2000, the date that the Disclosure was submitted to an IBM Attorney/Patent Professional. It is further established on the basis of the Affidavits and Disclosure that the inventors worked diligently with outside counsel through the intervening period up to the August 2, 2001, filing of the present application. Accordingly, the Disclosure and Affidavits demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as November 10, 2000, but no later than November 27, 2000, followed by due diligence through to the August 2, 2001, filing date for the instant application. Therefore, Applicants' invention predates the effective date of Bloebaum, which is January 23, 2001.

The internal procedures governing the use of the Disclosure dispel any question of possible substantive modifications following its submission to an IBM Attorney/Patent Professional. These internal procedures also lend support to the Applicants' acknowledged

diligence following conception. The Disclosure is the completion of an International Business Machines (IBM) Corporation confidential disclosure form, a standardized document utilized by IBM and submitted by its inventors upon conception of an invention. The document management system under which IBM confidential disclosure forms are generated does not permit amendments to be made to the form once it has been completed. Instead, any changes and/or additions are appended as an attachment to an IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the instant Disclosure, thus signifying that the Disclosure has not been substantively amended since its submission on November 27, 2000.

An IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. Further, according to the procedures governing an IBM confidential disclosure form, the inventors reviewed the application prior to its submission to the USPTO to insure that the claims and material contained therein were fully supported by the Disclosure.

As already pointed out, Applicants further exercised due diligence from prior to the effective date of Bloebaum until August 2, 2001, the filing date of the instant application. In regard to diligence, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application. Instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Bloebaum and exercised due diligence in constructively reducing the invention to practice

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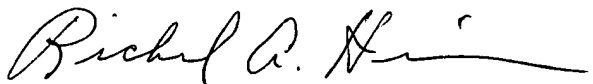
between the date of the Disclosure until the filing date, as supported by the enclosed Declarations, Bloebaum should be withdrawn as a reference for purposes of 35 U.S.C. § 103(a), which action is respectfully requested. Given that the rejection of each of independent Claims 1, 4, 6, 7, 12, 15 and 17 is based upon the combination of Bolnick, Harari, and Bloebaum, the withdrawal of Bloebaum as a reference establishes that the prior art provides no basis for rejecting any of the independent claims. It follows that since each dependent claim recites additional elements, the withdrawal of Bloebaum further establishes that the prior art provides no basis for rejecting any of dependent Claims 2, 3, 5, 8-11, 13, 14, or 16. Accordingly, Applicants respectfully request that the rejections of Claims 1-17 be withdrawn.

CONCLUSION

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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